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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/554,050	01/25/2006	Ji-Hyun Kim	Q90861	8300
23373	7590	11/02/2009	EXAMINER	
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			VAKILI, ZOHREH	
ART UNIT	PAPER NUMBER		1614	
MAIL DATE	DELIVERY MODE			
11/02/2009	PAPER			

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b>		Application No. 10/554,050	Applicant(s) KIM ET AL.
		Examiner ZOHREH VAKILI	Art Unit 1614
<p><b>– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –</b></p> <p>THE REPLY FILED <u>30 September 2009</u> FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.</p> <p>1. <input checked="" type="checkbox"/> The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:</p> <p>a) <input checked="" type="checkbox"/> The period for reply expires <u>5</u> months from the mailing date of the final rejection.</p> <p>b) <input type="checkbox"/> The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.</p> <p>Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).</p> <p>Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).</p> <p><b>NOTICE OF APPEAL</b></p> <p>2. <input type="checkbox"/> The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).</p> <p><b>AMENDMENTS</b></p> <p>3. <input checked="" type="checkbox"/> The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will <u>not</u> be entered because</p> <p>(a) <input checked="" type="checkbox"/> They raise new issues that would require further consideration and/or search (see NOTE below);</p> <p>(b) <input checked="" type="checkbox"/> They raise the issue of new matter (see NOTE below);</p> <p>(c) <input checked="" type="checkbox"/> They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or</p> <p>(d) <input type="checkbox"/> They present additional claims without canceling a corresponding number of finally rejected claims.</p> <p>NOTE: <u>See Continuation Sheet.</u> (See 37 CFR 1.116 and 41.33(a)).</p> <p>4. <input type="checkbox"/> The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).</p> <p>5. <input type="checkbox"/> Applicant's reply has overcome the following rejection(s): _____. </p> <p>6. <input type="checkbox"/> Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).</p> <p>7. <input checked="" type="checkbox"/> For purposes of appeal, the proposed amendment(s): a) <input checked="" type="checkbox"/> will not be entered, or b) <input type="checkbox"/> will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  The status of the claim(s) is (or will be) as follows:  Claim(s) allowed: _____.  Claim(s) objected to: _____.  Claim(s) rejected: <u>§</u>  Claim(s) withdrawn from consideration: <u>1-5</u>.</p> <p><b>AFFIDAVIT OR OTHER EVIDENCE</b></p> <p>8. <input type="checkbox"/> The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will <u>not</u> be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).</p> <p>9. <input type="checkbox"/> The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will <u>not</u> be entered because the affidavit or other evidence failed to overcome <u>all</u> rejections under appeal and/or appellant fail to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).</p> <p>10. <input type="checkbox"/> The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.</p> <p><b>REQUEST FOR RECONSIDERATION/OTHER</b></p> <p>11. <input checked="" type="checkbox"/> The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  <u>See Continuation Sheet.</u></p> <p>12. <input type="checkbox"/> Note the attached <i>Information Disclosure Statement(s)</i>. (PTO/SB/08) Paper No(s). _____</p> <p>13. <input type="checkbox"/> Other: _____.</p> <p>/Ardin Marschel/  Supervisory Patent Examiner, Art Unit 1614</p>			

Continuation of 3. NOTE: Applicant has proposed to amend the claim, filed 8/12/09, that requires further consideration and/or search. Applicant has added the specific inclusion of catechin per se, and not its inclusion only optionally, and an inactive ingredient that was not previously required. The new limitation, inactive ingredients, to the claims that raise the issue of new matter. New matter issues are raised when Applicant includes limitations in the claims that he/she clearly did not have possession of at the time of invention. The silence of the disclosure regarding the inactive ingredients is not sufficient to now claim the exclusion of such a step because nowhere in the disclosure has Applicant discussed the inactive ingredient in the context of the claimed composition.

Continuation of 11. does NOT place the application in condition for allowance because: Accordingly, Applicant's remarks regarding the obviation of the rejections of record under 103 in view of the amendments are also not found persuasive, because the proposed after final amendments will not be entered into the record. However, Applicant's remarks regarding the rejection of the claims over Spiegel and Ingram have been fully considered, but are not persuasive. In particular, clearly, the skilled artisan is provided with ample instruction and motivation to combine the mentioned ingredients such as theanine, genisteine, L-carnitine, and caffeine to produce a composition that has slimming effect. Both references are directed toward a formulation for suppressing weight gain. The prior arts teach of the same component and its concentration that is instantly claimed. Accordingly, it is well settled that products of identical chemical composition cannot have mutually exclusive properties. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. In other words, where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a *prima facie* case of either anticipation or obviousness has been established. See *In reBest*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). *In re Kerkhoven* (205 USPQ 1069, CCPA 1980) states that "It is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the same purpose: the idea of combining them flows logically from their having been individually taught in the prior art." Accordingly, the mentioned references make clear that the claimed components have been previously used in a composition that has slimming effect. As combined, the references have resulted in the claimed invention. The rejections are properly maintained for the reasons of record set forth in the final rejection of 5/12/2009.

/Zohreh Vakili/  
Patent Examiner  
Art Unit 1614